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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,454	02/05/2004	Alberto Nicoletti	108910-00121	2955

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EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,454

Applicant(s)

NICOLETTI ET AL.

Examiner

John m. Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments filed 11-4-05 have been fully considered but they are not persuasive.

The following rejections apply to the claims as they now stand. All other rejections are withdrawn in light of applicants' amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner (selected from the group "consisting of" A,B, and C) or alternatively (selected from A, B, or C). See M.P.E.P. 2173.05(h).

In claim 6, the term "the" should be deleted after "from". In claim 9, the term "or" should be placed between the second to last and last species.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kruecke et al.(6,080,799) in view of Moore et al.(5,658,962).

Kruecke et al. discloses preparations of polyurethane foams prepared from blowing agent combinations of 1,1,1,3,3-pentafluorobutane, and/or other hydrofluorocarbons, and/or other blowing agents as desired (see column 3 lines 45-53, as well as, the entire document).

Kruecke et al. differs from applicants' claims in that hydrofluoroalkyl ethers and/or other hydrofluoro-compounds as claimed by applicants are not particularly required. However, Moore et al. discloses these compounds, having boiling points, structures, and molecular weights as claimed based on their molecular make-ups, to be useful in polymeric foam preparations for the purpose of imparting acceptable foaming effects (see column 4 lines 10-12, and column 23, as well as, the entire document).

Accordingly, it would have been obvious for one having ordinary skill in the art to have been obvious for one having ordinary skill in the art to have employed the blowing agents of Moore et al. in the preparations of Kruecke et al. for the purpose of imparting their acceptable blowing and cell regulating effect in order to arrive at the products

and/or processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Additionally, as to the variations in the amounts of these respective species, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 , and it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Applicants' arguments have been considered, but rejection is maintained for the reasons set forth in the previous Office action. Applicants' arguments concerning behaviors of blowing agents in the art, foam failures in prepared compositions of their disclosure, and other comparative disclosures have been considered. However, these disclosures do not demonstrate examiner's position of prima facie obviousness to fail based on the combination of references as set forth. Further, applicants' showings of results fail to set forth a persuasive, factually supported, showing of new or unexpected results attributable to the combinations of their claims which are commensurate in scope with the scope of their claims. Further, evidence of unexpected properties must be demonstrated to be more significant than expected properties in order to rebut a prima facie case of obviousness.

That Kruecke et al.'s disclosure may be directed towards employment of binary azeotropic elements is not a feature excluded from applicants' claims, and employment

of such elements does not negate Kruecke et al.'s further provision for the employment of additional blowing gases (column 3 line 54).

Claims 1-3, 5-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kruecke et al.(6,6,380,275) in view of Klug et al.(5,605,882).

Kruecke et al. discloses preparations of polyurethane foams prepared from blowing agent combinations of 1,1,1,3,3-pentafluorobutane, and/or other hydrofluorocarbons, and/or other blowing agents as desired (see the entire document).

Kruecke et al. differs from applicants' claims in that hydrofluoroalkyl ethers and/or other hydrofluoro-compounds as claimed by applicants are not particularly required. However, Klug et al. discloses these compounds, having boiling points as claimed based on their structures, to be useful in polymeric foam preparations for the purpose of imparting acceptable foaming effects (see the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have been obvious for one having ordinary skill in the art to have employed the blowing agents of Klug et al. in the preparations of Kruecke et al. for the purpose of imparting their acceptable blowing and cell regulating effect in order to arrive at the products and/or processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Additionally, as to the variations in the amounts of these respective species, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only

routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 , and it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Applicants' arguments have been considered, but rejection is maintained for the reasons set forth in the previous Office action. Rejection is maintained to be proper for the reason set forth above. Applicants' mixtures as claimed do not distinguish or rebut the position of prima facie obviousness based on the fact that Klug et al. is directed towards azeotropic compositions. The existence of azeotropic states and/or employment of azeotropic elements are not conditions which are excluded from the limitations of applicants' claims.

Examiner's position of prima facie obviousness is maintained to be proper, and applicants' showings of results fail to set forth a persuasive, factually supported, showing of new or unexpected results attributable to the combinations of their claims which are commensurate in scope with the scope of their claims. Further, evidence of unexpected properties must be demonstrated to be more significant than expected properties in order to rebut a prima facie case of obviousness.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1711

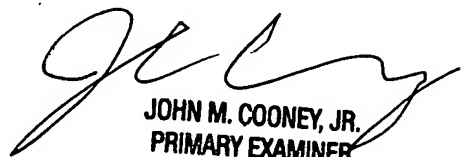
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700